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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/052,960	01/17/2002	Richardf L. Goodin	S63.2-9696	3347
490	7590	10/01/2004	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			SIRMONS, KEVIN C	
		ART UNIT	PAPER NUMBER	
			3763	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/052,960	GOODIN ET AL.
	Examiner	Art Unit
	Kevin C. Sirmons	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 21 July 2004.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-4, 6-12, 14, 15 and 18-24 is/are pending in the application.
  - 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 6-12, 14 and 15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Keith et al U.S. Pat. No. 5,395,334.

Keith discloses a first component (82) and a second component (36), in the pre-assembly state at least a portion of the first component overlapping at a bonding site at least a portion of the second component (fig. 2), the at least a portion of the first component having a first outer diameter and the at least a portion of the second component having a second outside diameter (fig. 2); and a third component (adhesive (no reference numeral given)), in the pre-assembly state at least a portion of the third component overlapping at the bonding side at least one of the at least a portion of the first component and the at least a portion of the second component (fig. 2), the at least a portion of the third component having a third outer diameter (fig. 2), wherein in the assembled state the at least a portion of the first outside diameter being substantially equal to the second outside diameter and the at least a portion of the third outside diameter being substantially equal to the first outside diameter (fig. 2); as to claim 2, (82); as to claim 3, (36/38); as to claim 4, (36/38); as to claim 7, (fig. 2); as to claim 8, (36/38); as to claim 14, (26); as to claim 15, (26).

Claims 1-4, 6-12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sogard U.S. Pat. No. 5,447,497.

Sogard discloses a first component (20) and a second component (26), in the pre-assembly state at least a portion of the first component overlapping at a bonding site at least a portion of the second component (fig. 3 and 4), the at least a portion of the first component having a first outer diameter and the at least a portion of the second component having a second outside diameter (fig. 3 and 4); and a third component (28), in the pre-assembly state at least a portion of the third component over lapping at the bonding side at least one of the at least a portion of the first component and the at least a portion of the second component (fig. 3 and 4), the at least a portion of the third component having a third outer diameter (fig. 3 and 4), wherein in the assembled state the at least a portion of the first outside diameter being substantially equal to the second outside diameter and the at least a portion of the third outside diameter being substantially equal to the first outside diameter (fig. 3); as to claims 2-4, (fig. 3); as to claim 6, (3 and 4); as to claims 9 and 11-13, (the same rejection as above applies in this rejection); as to claims 7, 8, 14 and 15, (figs. 3 and 4).

*Response to Amendment*

*Drawings*

Applicant has amended the drawings to overcome the objections. Therefore, the objections have been withdrawn.

***Response to Arguments***

Applicant's arguments filed 7/21/04 have been fully considered but they are not persuasive.

In response to applicant's argument that Keith does not teach an assembled state wherein the outer diameter of the first component is substantially equal to the outer diameter of the second and third component, it is the examiner's position that after reviewing the drawings there are clearly portions of the first, second and third components which have a substantially equal outer diameter (fig. 2).

As to Sogard, he clearly discloses a catheter having all of the elements of claims 1. Sogard discloses a catheter having three components, which when in the assembled state the outer diameter of a portion of the first component is substantially equal to the outer diameter of the second and third components (figs. 3 and 4).

In the application, applicant clearly has claims that are considered product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698 227 USPQ 964, (66(Fed. Cir. 1985)). Basically, Keith and Sogard disclose a catheter having the recited structural relation between the first, second and third components. The end structure of the claimed invention is equivalent to the invention as disclosed by Keith and Sogard. Clearly, the first, second and third components are bonded together.

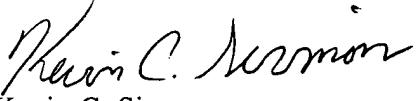
The claim describes how they are bonded together which indicates a process. Process limitations in a product claim are given little patentable weight.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

  
Kevin C. Sirmons  
Patent Examiner  
9/23/04